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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/978,753 11/26/97 MARKOVIC

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ROGER S BOROVVOY
FISH & RICHARDSON
2200 SAND HILL ROAD
SUITE 100
MENLO PARK CA 94025

ART UNIT	PAPER NUMBER
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PAULA, C

DATE MAILED:
2776

09/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/978,753

Applicant(s)

Markovic et al.

Examiner

Cesar B. Paula

Group Art Unit

2776

☒ Responsive to communication(s) filed on Nov 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 13, 15-28, 31, and 32 is/are rejected.

☒ Claim(s) 5-12, 14, 29, 30, and 33-38 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This action is responsive to the application filed 11/26/97, and preliminary amendments filed on 5/9/98, and 11/20/98.

This action is made non-final.

2. In the amendment claims 1-38 are pending in the case, claims 28-38 have been added. Claims 1, 23, 24 and 27 are independent claims.

Drawings

3. The drawings filed on 11/26/97 have been approved by the draftsman.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

5. The following title is suggested: METHOD AND APPARATUS TO DISPLAY THE APPEARANCE OF PRINTED DOCUMENT.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 13, 15-28, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMaria (Pat.# 4,174,175, 2/1/78) in view of Slayden et al (Pat.# 5,652,901, 6/7/95).

Regarding independent claim 1, DiMaria discloses *receiving in a copier a first electronic document*--"..The documents.....placed under the cover plate of the copier." (col. 1,16-18).

DiMaria fails to disclose *receiving in a computer a first electronic document*, However, Slayden et al disclose "...method and system for previewing computer output..." (col. 1,10-11) It would have been obvious to have combined DiMaria and Slayden et al, because DiMaria discloses "....apparatus for previewing and copying documents.." (col. 1,46-47). A computer system could have been used for the task of previewing these documents.

Moreover, DiMaria discloses *receiving in the copier a user input*.....--"..the documents.....assembled loosely" (col. 1,16-18). DiMaria fails to disclose *receiving in a computer a user input*However, Slayden et al disclose "...method and system for previewing computer output..." (col. 1,10-11). It would have been obvious to have combined DiMaria and Slayden et al, because DiMaria discloses "....apparatus for previewing and copying documents.." (col. 1,46-47). A computer system could have been used for the task of receiving the user input.

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Moreover, DiMaria discloses *determining a visual appearance of the first electronic document*.....--"..a document.....may be first previewed....." (col. 1, 53-54). The document was previewed--determine visual appearance--before the printing of it by the copier. DiMaria fails to disclose *determining in the computer a visual appearance*.....However, Slayden et al disclose "...method and system for previewing computer output..." (col. 1,10-11)

It would have been obvious to have combined DiMaria and Slayden et al, because DiMaria discloses "....apparatus for previewing and copying documents.." (col. 1,46-47). A computer system could have been used for the task of determining in the computer a visual appearance.

Furthermore, DiMaria discloses *producing as output the determined visual appearance*--"..the document.....could be copied....." (col. 2, 10-11). After previewing the document, it was copied--produced.

Regarding dependent claim 2, DiMaria discloses *generating a second electronic document which depicts the first electronic document*.....-- "operator can preview the document exactly as it will appear in a copy prior to the copy being made....." (col. 1, 48-49). The "preview"--*second electronic document which depicts the first electronic document*, before it was printed and assembled.

Regarding dependent claim 3, DiMaria discloses *receiving a second user input that selects a second instruction for assembling the hard copy document*.....-- "if.....assemblage is not as desired, it must be rearranged and another copy produced....." (col. 1, 20-22). If the user was not content with the look of the document in the preview, then the document was rearranged *to generate a second electronic document showing the first electronic document once printed*.

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Regarding dependent claim 4, DiMaria discloses *receiving a second user input that selects a second instruction for assembling the hard copy document.....*-- “if.....assemblage is not as desired, it must be rearranged and another copy produced.....” (col. 1, 20-22). If the user was not content with the look of the document in the preview, then the document was rearranged-
- *modified to generate a second electronic document.*

Regarding dependent claim 13, DiMaria discloses *...the instruction identifies a printing media to be used in the hard copy document--* “a document to be copied may be first previewed.....” (col. 1, 23-24). The user had the freedom *to identify the printing media* to be used in copying the document.

Regarding dependent claim 15, DiMaria discloses *...the instruction identifies a pre-existing image on the printing media--* “a document to be copied may be first previewed.....” (col. 1, 23-24). The user had the freedom *to identify the a pre-existing image on the printing media*, such as watermarks commonly known in the art.

Regarding dependent claim 16, DiMaria discloses *...the instruction identifies a cover to be used in the hard copy document--* “a document to be copied may be first previewed.....” (col. 1, 23-24). The user had the freedom *also to identify the cover* to be used in the hard copy document.

Regarding dependent claim 17, DiMaria discloses *...the instruction identifies a binding to be used in the hard copy document--* “a document to be copied may be first previewed.....” (col. 1, 23-24). The user had the freedom *also to identify a binding* to be used in the hard copy document.

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Regarding dependent claim 18, DiMaria discloses ...*the instruction identifies a velo(TM), spiral...*-- "a document to be copied may be first previewed....." (col. 1, 23-24). The user had the freedom also *to identify a velo (TM), spiral etc.* to be used in the hard copy document through the preview.

Regarding dependent claim 19, DiMaria discloses ...*the instruction identifies a physical modification of the printing media.*-- "a document to be copied may be first previewed....." (col. 1, 23-24). The user had the freedom also *to identify a physical modification* made on the document through the preview.

Regarding dependent claim 20, DiMaria discloses ...*the instruction identifies hole punching, folding, or cutting of the printing media.*-- "a document to be copied may be first previewed....." (col. 1, 23-24). The user had the freedom also *to identify hole punching, folding, or cutting of the printing media* made on the document through the preview.

Regarding dependent claim 21, DiMaria fails to disclose ...*the user input is received through an interactive user interface.* However, Slayden et al teach-- "...the visual interface that the facility provides....." (col. 5, 48-49). It would have been obvious to have combined DiMaria and Slayden et al, because DiMaria discloses "...apparatus for previewing and copying documents.." (col. 1, 46-47). A user interface such as disclosed by Slayden et al and commonly known in the art, could have been used for the task of previewing these documents.

Regarding dependent claim 22, DiMaria fails to disclose ...*receiving the user input includes displaying a plurality of instruction identifiers.....* However, Slayden et al teach-- "...navigation controls, which the user utilizes to view portions of the document not presently

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visible.....which allow the user to select a different preview position....." (col. 6, 10-14). It would have been obvious to have combined DiMaria and Slayden et al, because DiMaria discloses "....apparatus for previewing and copying documents.." (col. 1, 46-47). These "navigation controls"--*document identifiers*--aided in the preview of the document.

Independent claim 23 is directed towards a method for displaying the finished form of a second electronic document for characterizing the steps found in claim 1 and is similarly rejected.

Independent claim 24 is directed towards a computer-assisted method for of creating a hard copy document for characterizing the steps found in claim 1 and is similarly rejected.

Regarding dependent claim 25, DiMaria discloses ...*the document assembler prints the electronic document to create the hard copy document.*-- ".....assemblage is not as desired, it must be rearranged and another copy produced....." (col. 1, 21-22). The copy was *assembled in accordance to user's instruction.*

Regarding dependent claim 26, DiMaria discloses ...*the document assembler prints the electronic document to create the hard copy document.*-- ".....assemblage is not as desired, it must be rearranged and another copy produced....." (col. 1, 21-22). If the user was not happy with the preview of the document, then a second copy was *assembled in accordance to user's instruction.*

Independent claim 27 is directed towards a computer program stored on a computer-readable medium for characterizing the steps found in claim 1 and is similarly rejected.

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Regarding dependent claim 28, DiMaria fails to disclose *...the computer receives user input that selects a plurality of instructions*. However, Slayden et al teach-- “...navigation controls, which the user utilizes to view portions of the document not presently visible.....which allow the user to select a different preview position.....” (col. 6, 10-14). It would have been obvious to have combined DiMaria and Slayden et al, because DiMaria discloses “....apparatus for previewing and copying documents..” (col. 1, 46-47). These “navigation controls” allowed the user to input several instructions to preview different positions of the document.

Regarding dependent claim 30, DiMaria discloses *...the instruction identifies cutting of the printing media*-- “a document to be copied may be first previewed.....” (col. 1, 23-24). The user had the freedom also *to identify cutting of the printing media* made on the document through the preview.

Regarding dependent claim 31, DiMaria discloses *...the instruction identifies folding of the printing media*-- “a document to be copied may be first previewed.....” (col. 1, 23-24). The user had the freedom also *to identify folding of the printing media* made on the document through the preview.

Claim Objections

Claims 29, and 29 are objected to for having the same number. The examiner requests the renumbering of these claims appropriately.

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Claims 5-12, 14, 29-30 and 33-38 are objected to for incorporating the deficiencies of their respective independent claims and would be allowable if rewritten in independent form.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gasper et al. (Pat. # 5,864,742), Tuhro (Pat. # 5,017,963), Plasencia et al. (Pat. # 4,558,373), and Chavez (Pat. # 5,822,080).


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached on (703) 305-4713. However, in such a case, please allow at least one business day. The formal and informal fax phone numbers for this Group are (703) 308-9051 and 308-5403 respectively.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

CBP

August 30, 1999



MICHAEL RAZAVI
SUPERVISORY PATENT EXAMINER
GROUP 2700